

## REMARKS

### Status of Claims

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13-15, 21-26, 31, 34, 35, 38-47 and 50 to 54 were pending as shown above and claims 34 and 50-54 were under active examination. Claims 34 and 50 have been amended to make explicit that the polypeptide consists essentially of a zinc finger polypeptide and to make explicit that the ligand does not comprise the target site. Claims 50-52 have been amended for clarity. Thus, 1, 2, 4, 5, 7, 8, 10, 11, 13-15, 21-26, 31, 34, 35, 38-47 and 50 to 54 are pending as shown above and claims 34 and 50-54 are under active examination.

### Priority

Pursuant to the Examiner's request, it is now made explicit in the Cross Reference to Related Paragraph that the U.S. National Phase is a continuation of PCT/GB00/02080. Applicants submit that a Petition is not required as the information concerning the benefit claim was recognized by the Office as shown by inclusion on the first filing receipt.

### 35 U.S.C. § 112, 2<sup>nd</sup> paragraph

Claims 53-54 were rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as allegedly indefinite in reciting a "protein switch." (Office Action, page 5).

Applicants thank the Examiner of the suggested remedial language and have incorporated the language by amendment above, thereby obviating the rejection.

### 35 U.S.C. § 102(b)

Claims 34, 51, 52 and 54 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Corbi et al. (1997) *Febs. Letts.* 471:71-74 (hereinafter "Corbi"), which was cited for allegedly teaching that the "Mago" zinc finger polypeptide becomes dissociated from a (labeled) probe containing the Mago target site in the presence of the same (unlabeled) probe. (Office Action, page 6).

Applicants traverse the rejection. In the competition assays described in Corbi, the ligand and target site are one and the same. Accordingly, with either an unlabeled or a labeled probe, the Mago protein binds to the target site in the probe. It is simply a question of detection – binding to the labeled probe is detected whereas binding to the unlabeled probe is not. Mago does not become dissociated from the target site in the presence of an unlabeled ligand, it simply binds to the same target site on an unlabeled probe. Accordingly, the rejection is improper and cannot be sustained.

Nonetheless, solely in an effort to expedite prosecution, the claims have been amended to make explicit that the ligand does not comprise the target site. Thus, in any event, the rejection has been obviated.

**35 U.S.C. § 103(a)**

Christopherson

Claims 34, 50, 52 and 53 were newly rejected under 35 U.S.C. §103(a) as allegedly obvious over Christopherson et al. (1992) *Proc. Nat'l. Acad. Sci. USA* 89:6314-6318 (“Christopherson”) in view of WO 98/53059 (hereinafter “Choo”). (Office Action, pages 6-10). The rejection is premised on the assertion that it would have been obvious to one of skill in the art to replace the DNA binding domain of Christopherson’s protein with a non-naturally occurring C2H2 zinc finger DNA binding domain of Choo. *Id.*

While there is nothing in any combination of Christopherson and Choo that teaches a non-naturally occurring C2H2 zinc finger DNA binding domain and a steroid hormone DNA-binding domain are necessarily interchangeable, the foregoing amendments obviate the rejection. In particular, the claims now make explicit that the polypeptide is not a fusion of a zinc finger DNA binding domain and a ligand receptor domain. Rather, the ligand binds to the zinc finger protein. Christopherson relates only to fusion proteins of heterologous DNA and ligand-binding domains. Accordingly, there is no combination of Christopherson and Choo and teaches or suggests the claimed subject matter and withdrawal of the rejection is in order.

Lim

Claims 52 and 54 were newly rejected under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent No. 7,189,506 ("Lim") in view of Choo. (Office Action, pages 10-12).

Lim teaches only complexes including a fusion protein comprising a DNA binding domain and a heterologous regulatory domain. Thus, Lim fails to teach or suggest a complex or composition as claimed (not including a fusion protein) and withdrawal of the rejection is in order.


**CONCLUSION**

For the reasons stated above, Applicants respectfully submit that the pending claims are in condition for allowance.

Respectfully submitted,

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